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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,232	03/25/2005	Alain-Nicolas Gilg	0510-1111	2145
466	7590	09/24/2007		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER PREBILIC, PAUL B	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 09/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,232

Applicant(s)

GILG, ALAIN-NICOLAS

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

The information disclosure statement filed March 25, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The foreign patent documents have been struck therefrom, but have been considered and cited on the enclosed PTO-892 form.

Specification

The disclosure is objected to because of the following informalities:

There are no section headings in the specification as suggested by 37 CFR 1.77.

The brief descriptions of Figures 2 and 3 suggest that there is a separate figure labeled "Figure 2" and "Figure 3", respectively. However, there are only figures numbered 2a, 2b, 3a, and 3b. For this reason, the brief description is considered confusing.

In the abstract, on line 1, the term "affection" is awkward. The Examiner suggests changing "affection" to ---condition--- in order to be clearer.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 3, 6, 8, 9, 10, 11, 13, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 3, there is a broader range followed by a narrower range. For this reason, it is not clear which range is applicable.

With regard to claim 6, line 2, it is unclear which "diameter" is referenced.

With regard to claims 8, 9, and 15, the claim language appears to positively require the fluid even though the base claim did not. For this reason, it is not clear whether the fluid is a positive element of the claims.

With regard to claims 10 and 11, the Markush language is improper in that the listing appears to contain multiple usages of "and"; see MPEP 2173.05(h). Due to the multiple usages of "and", it is not clear where the listing ends.

With regard to claim 13, the pronoun "it" is considered indefinite because it is unclear what element "it" is referencing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 8, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Silvestrini et al (US 5,466,260). Silvestrini anticipates the claim language where the envelope as claimed is the ring (90) of Silvestrini, and the

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aperture as claimed is the nozzle (91); see Figures 9A and 9B and column 9, lines 22-54. The Silvestrini device is fully capable of being used in the ciliary sulcus to treat an ocular condition as claimed because it has the same structure as that claimed.

With regard to claim 9, the limitations of this claim were treated as functional or inferential in nature only. The Examiner asserts that the Silvestrini device is fully capable of performing the function recited.

With regard to claim 12, the Examiner asserts that the nozzle allows this.

Claims 1, 2, 5, 8-12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Feaster (US 4,902,293). Feaster anticipates the claim language fully; see the figures and columns 3 and 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6, 7, 10, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silvestrini et al (US 5,466,260) in view of Lee (WO 98/25547). Silvestrini discloses a resilient flexible wall material but not clearly an elastomeric material as claimed. However, Lee teaches that silicone (which is foldable and deformable and thus also inherently elastomeric) has been utilized in similar devices within the art; see page 12, lines 22-35. Therefore, it is the

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Examiner's position that it would have been obvious to utilize silicone as the resilient flexible material of Silvestrini for the same reasons that Lee utilizes the same and because silicone is a well tolerated implant material.

With regard to claims 3 and 6, the claimed dimensions are taught by Lee; see page 13, lines 15-34. Therefore, it is the Examiner's position that it would have been obvious to utilize such dimensions when making the Silvestrini device so that it could be utilized in a vast majority of human patients.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feaster (US 4,902,293) in view of Hara et al (US 5,275,624). Feaster fails only to disclose a groove to accommodate a lens as claimed. However, Hara teaches that it was known to make similar devices with grooves to facilitate lenses. Therefore, it is the Examiner's position that it would have been obvious to modify Feaster to include a groove to allow separate implantation of the lens for the same reasons that Hara utilizes the same and in order that allow modular adaptability of the device with respect to the patient's needs.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office

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action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
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